

REMARKS

Summary of the Office Action

Claims 1, 2, 4, 6-7, 9, 14, 17-18 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,292,685 to Pompei.

Claims 3, 13 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,292,685 to Pompei in view of U.S. Patent No. 6,047,205 to Pompei.

Claims 8 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,292,685 to Pompei in view of U.S. Patent No. 5,893,833 to Pompei et al.

Claims 5 and 16 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Summary of the Response to the Office Action

Claims 1 and 2 have been amended to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Claims 1-9 and 13-20 are presently pending for consideration.

All Claims Comply with 35 U.S.C. § 102(b)

Claims 1, 2, 4, 6-7, 9, 14, 17-18 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,292,685 to Pompei (hereinafter "Pompei '685"). To the extent that the Examiner may consider this rejection to still apply to independent claims 1 and 2, as

amended, the rejection is respectfully traversed as being based upon a reference that does not anticipate the novel combination of features now recited in independent claims 1 and 2. For example, claim 1 now recites, amongst other features, “a probe tip (2) for taking temperature reading in an ear canal” and a “probe head (5) for taking temperature readings on skin surfaces.” In another example, claim 2 now recites, amongst other features, “a probe tip (2) for taking temperature readings in an ear canal” and a “a probe head (5) used in combination with the probe tip for taking temperature readings on skin surfaces.” Support for these features can be found at lines 1-3 on page 5 of the present application, as well as, in the Figures of the present application.

In contrast to the presently claimed invention, Pompei ‘685 discloses a thermometer that is configured for taking temperature readings only on skin surfaces. Applicants respectfully assert that there is no disclosure in Pompei ‘685 of a thermometer that can be used to take temperature readings in the ear canal and on skin surfaces. Although several embodiments are shown in Pompei ‘685, none of the embodiments have a configuration for taking temperature readings in an ear canal. Further, Applicants also respectfully assert that Pompei ‘685 has no disclosure of a probe head for taking temperature readings on skin surfaces that is demountably attachable to a probe tip for taking temperature readings in an ear canal. Furthermore, Applicants also respectfully assert that Pompei ‘685 has no disclosure of a thermometer having a probe tip for taking temperature readings in an ear canal that can be used in combination with a probe head for taking temperature readings on skin surfaces.

For at least the above reasons, Applicants respectfully assert that Pompei '685 fails to anticipate every feature recited in independent claims 1 and 2, as amended. Moreover, dependent claims 4, 6-7, 9, 14, 17-18 and 20 are allowable over Pompei '685 for the same reasons as discussed above and for the additional features that they recite. Accordingly, Applicants respectfully request that the 35 U.S.C. § 102(b) rejection of claims 1, 2, 4, 6-7, 9, 14, 17-18 and 20 as being anticipated by Pompei '685 be withdrawn.

All Claims Comply with 35 U.S.C. § 103(a)

Claims 3, 13 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pompei '685 in view of U.S. Patent No. 6,047,205 to Pompei (hereinafter "Pompei '205"). Claims 8 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pompei '685 in view of U.S. Patent No. 5,893,833 to Pompei et al. To the extent that the Examiner may consider these rejections to still apply, Applicants respectfully assert that the combinations of Pompei '685 together with Pompei '205 and Pompei '685 together with Pompei et al. in these rejection do not make up for the deficiencies of Pompei '685 as discussed above with regard to amended independent claims 1 and 2. In particular, Applicants respectfully submit that Pompei '685, Pompei '205 and Pompei et al., either singly or combined, do not teach or suggest "a probe tip" and a "probe head," as recited in either of amended independent claims 1 and 2.

Moreover, Applicants respectfully submit that there is no motivation to combine Pompei '685 together with Pompei '205 or Pompei '685 together with Pompei et al. to teach the invention now recited in independent claims 1 and 2, as amended. MPEP § 2143.01 instructs

that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)." Applicants respectfully submit that the cited references do not provide such a suggestion or motivation. Applicants also respectfully submit that the only motivation to combine Pompei '685 together with Pompei '205 or Pompei '685 together with Pompei et al. would only be found exclusively within Applicants' own application. MPEP § 2141 instructs that "the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention." MPEP § 2143 instructs that "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art rather than in Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ 1438 (Fed. Cir. 1991)." The Federal Circuit has clearly held that "the motivation to combine references cannot come from the invention itself." Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 30 USPQ 2d 1377 (Fed. Cir. 1993).

For at least the above reasons, Applicants respectfully assert that Pompei '685, Pompei '205 and Pompei et al. fail to teach or suggest, either separately or combined, every feature recited in independent claims 1 and 2, as amended. Moreover, dependent claims 3, 8, 13, 15 and 19 are allowable over Pompei '685, Pompei '205 and Pompei et al., either singly or combined, for the same reasons as discussed above and for the additional features that dependent claims 3, 8, 13, 15 and 19 recite. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections of claims 3, 8, 13, 15 and 19.

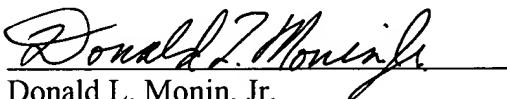
CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By: 
Donald L. Monin, Jr.
Reg. No. 47,256

Dated: February 25, 2004

Customer No.: 009629

MORGAN, LEWIS & BOCKIUS LLP

1111 Pennsylvania Avenue, N.W.

Washington, D.C. 20004

Telephone: 202-739-7000

Facsimile: 202-739-3001